

**REMARKS**

Claims 1-33 and 34-35 were pending when the Final Office Action was mailed on 10-May-2007 (hereafter "First Final Office Action"). Claims 1-20 and 26-33 were in withdrawn status. Claims 21-25, 34 and 35 were rejected.

By virtue of this paper, claims 1-20 are sought to be canceled and withdrawn claim 28 is sought to be amended. The amendments and cancellation are made without prejudice or disclaimer. Claims 26-33 remain withdrawn. Claims 21-25, 34 and 35 are presented for reconsideration further in view of the below remarks.

***Telephone Interview***

As noted above, a telephone interview was conducted with Examiner Fortuna on January 17, 2007. Examiner Fortuna, Mr. Gary Burma (inventor) and the undersigned representative are believed to be the participants.

Patent Number WO 02/42555A1 naming as inventors Lipponen et al (hereafter Lipponen), and US Patent Number 4,152,202 issued to DeLigt (hereafter DeLigt) were discussed in relation to the claimed actuators "... operable to perform a ... control action to manipulate a cross-directional shape within said slice...".

It was explained that neither reference teaches or reasonably suggests such a feature. The Examiner appeared to agree in that respect, but noted that the rejection under 35 U.S.C. § 103 would be maintained under the recent USSC case on KSR International Co. V. Teleflex Inc. *et al* (hereafter KSR). The undersigned representative agreed to address that aspect in this paper.

The applicant is believed to have met the burden of making of record the Substance of the Interview. The Examiner is respectfully requested to send a duly completed Interview Summary form PTOL 413 if one has not been sent already. See MPEP 713.04 for further clarification.

***Elections/Restriction***

In the Office Action Dated 06/06/2006, it was stated that:

5           Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).  
(Line 20 Page 2 to Line 2 of page 3 of the Office Action Dated 06/06/2006)

10           It is believed that pending independent claim 21 is a generic claim that covers all the pending withdrawn claims 26-32.

          Should claim 21 be found to be allowable, the Examiner is respectfully requested to pass claims 26-32 also to allowance. If needed, the Examiner is hereby authorized to change the status of the withdrawn claims by Examiner's amendment to place the application in condition for allowance.

15           It is further noted that claims 34 and 35 were added after the election and are generic claims as well.

          It is also noted that the subject application is a parent of US (divisional) Application Number 11/307,499 (now US Patent Number: 7,146,238). The Examiner is respectfully requested to thoroughly examine the file wrapper, along with the art of record in that related application.  
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***Rejections under 35 U.S.C. §§ 102/103***

          As noted above with respect to Examiner Interview, neither of the references (DeLight and Lipponen) teaches claimed actuator "... operable to perform a ... control action to manipulate a cross-directional shape within said slice...".

25           The Examiner then appears to rely on KSR to assert that the two references render claim 21 obvious under 35 U.S.C. § 103.

It is respectfully noted that KSR did not circumvent the analysis under *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 17-18. The analysis requires determination of the scope and content of the prior art; ascertaining the differences between the prior art and the claims at issue; and resolving the level of ordinary skill in the pertinent art. Seeking to  
5 resolve the obviousness question with more uniformity and consistency, the Federal Circuit has employed a “teaching, suggestion, or motivation” (TSM) test.

In KSR, the Supreme Court took exception to a rigid formulation of the TSM test by the CAFC. At the appellate level, the CAFC had held that the District Court’s re-course to the nature of the problem to be solved was insufficient be-cause, unless the prior art  
10 references addressed the precise problem that the patentee was trying to solve, the problem would not motivate an inventor to look at those references. The Supreme Court disagreed with such a rigid formulation of the TSM test.

However, Supreme Court did not discard the TSM test.

In addition, the analysis of KSR is believed to apply only when the references of  
15 record show the individual elements of the claim and the question is whether there is sufficient motivation to combine the elements of references as in the claim.

KSR is not intended to change the result (under 35 U.S.C. § 103) in cases such as here when none of the references teach or suggest a claimed element/feature.

Neither does *In re Farenkopf*, 713 F2d714; 214 USPQ 1. At least from the language  
20 below, it appears this case also addresses threshold requirements when combining references (not when neither reference teaches a claimed element/feature):

. Even if the nozzles are moved as a whole, since the flow of nozzle, i.e., the magnitude, is operated individually, the device reads on the claims as claimed, since each nozzle would vary the magnitude and shape of the profile. Moreover, it is the  
25 examiner contention that moving the nozzles individually is within the levels of ordinary skill in the art, if a more precise control of the profile is desired. Note that in view of the advances on microchips and microcomputers, it is not only easier to control individual equipment in any operation, but also economical. It has been held that “[A] **combination of reference** teachings may be obvious in the technological

sense even though business or economic considerations would previously have counseled against such a combination." In re Farenkopf, 713 F2d 714; 219 USPQ 1. (Line 17 page 2 through line 5 page 3 of the First Final Office Action, ***Emphasis Added***)

5           Furthermore, the burden is on the Patent Office to set forth a prima facie case under 35 U.S.C. § 103. That burden has clearly not been met.

Accordingly, it is contended that independent claim 21 is allowable the references of record.

10           All the rejections and objections are thus believed to have been overcome. Withdrawal of the outstanding objections and rejections, and continuation of examination is respectfully requested. The Examiner is invited to telephone Mr. Anthony Miologos at 602-313-5683 if it is believed that an interview might be useful for any reason.

Respectfully submitted,

/Narendra R Thappeta/

Signature

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